

## REMARKS

The Office Action mailed 07/16/2007 has been received and reviewed. In order to expedite the prosecution, applicant canceled claims 16-25 and added new claims 26-37. Upon entry of the foregoing amendments, the claims currently under consideration are claims 26-37. Claim 26 corresponds roughly to previous claim 16, previously allowed but then later withdrawn from allowance, now canceled, but also including several changes. Claim 26 now describes the process from beginning to end, with the steps listed in the order they are to be performed as an element of the claim. Claim 26 describes the pigment to oil mixture as a specific mixture in a 1:1 ratio.

There are other significant changes in new claim 26 as compared to previously allowed, later withdrawn, now canceled, claim 16. The first significant change is the addition of the word thin before the word “water” when describing the layer of water to be placed upon the water color paper or canvas. Thus claim 26 identifiers “d” and “k” read, “moisturizing said water color paper or canvas to form a thin film of water on said paper or canvas using a spray or brush to wet said paper or canvas.” The word “thin” has qualifiers and definition. The thin film must be thin enough to allow the paint to touch the canvas. The thin film must be applied “with a spray or brush to wet said paper or canvas” thus clearly distinguishing it from prior art where paint is floated on water, then lifted from the water. Related to the thin film of water is the directed movement of the paint that must interact with the wetted paper or canvas in elements m and n, thus producing a specific image rather than random marbling.

Support for this change can be found in the specification at page 3, lines 25-27, page 4, lines 27-30, page 5, lines 24 and 31, page 6, lines 18 and 24. The claim is now limited to using a thin film of water, this is in contrast to a “bath” where the pigment rides on a layer of water above the paper and does not interact with the paper or transferring medium.

Claim 26, in elements e and l, describes the use of two or more pigment colors rather than “one or multiple flowing colors.” Support for use of two or more pigment colors can be found throughout the specification where the plural form of the word color(s) is used. Colors, plural, can be found in particular in the following places, page 3,

lines 30-32, page 4, lines 1, 7, page 5, lines 1, 4, 9, 21, 26, 31 and in numerous other places. Multiple colors in fact are preferred and the new claims reflect this.

The novel process described by Applicant is a result of the interaction between the pigment, the oil, the water and the paper or canvas, which can only be achieved with a thin film of water sprayed or brushed on the paper or canvas.

Applicant has removed references to animal and vegetable fats.

These new claims and their dependent counter parts, now accurately describe the process to be claimed and they clearly distinguish the invention from the references cited by the Examiner.

Applicant also seeks to change the title of the application from “A Novel Method for Oil Paintings” and to replace the oil title with the new title of “Flowing Colors Oil Painting.” The title is more descriptive of the process and provides more information about the process claimed. That is, the oil flows (on a thin film of water) and it uses two or more colors (plural form of color (s) now included as a claim element ) in the new pending claims.

#### **Responding to the specific objections raised in the Office Action.**

In the Office Action it was first noted that the identifiers (a-g) were repeated for different steps and were confusing. New claim 26 uses only one letter per step and none are repeated. The Examiner also objected that claim 24 used an unusual reference to a broader claim, “the oil of claim 18.” Such references are removed in the new claims.

The Examiner cited several references in order to make obviousness arguments under 35 USC 103 concerning Applicant’s invention. Those concerns are addressed in the amendments above with the new claims. Applicant believes the new claims have none of the objected to elements raised in the Office Action and thus they are all now moot.

Taubl ‘989 in view of Lynden ‘871, Talmas (Oil and Water Painting) and with or without “Water Art.” The Examiner asserted: “Taubl teaches preparing a canvas (col. 4, lines 44-46), placing a blank transferring paper (col. 3, lines 60-65) inside a base pan (col. 2, line 28), moisturizing the blank transferring paper to form a film of water (col. 2, line 39), depositing one or multiple flowing colors on the wetted blank transferring paper

(col. 2, lines 46-67)[the step of submerging the blank transferring paper in the water and paint meets the step of moisturizing the blank with water and depositing colors], directing the flowing colors to flow freely and mix with each other (marbling in col. 1, line 10), facing the canvas (col. 4, lines 44-46) to the transferring paper (col. 3, lines 61-65, and transferring the flowing colors from the transferring paper (col. 3, lines 60-65) to the canvas (col. 4, lines 44-46). The Examiner further explained that Taubl does not specifically disclose that the canvas is a “painted” canvas and the making of the “painted canvas” including placing a blank canvas inside a base pan, moisturizing the blank canvas to form a film of water, depositing one or multiple flowing colors on the wetted blank canvas, directing the ...[etc.]”

Applicant appreciates the Examiner carefully citing to the reference with column and line cites; however, one important comment quoted above is in fact not found in Taubl. Taubl never uses the term “moisturizing” in reference to wetting the canvas. Taubl uses the word “bath” and “bath surface.” Bath is used at least 9 times in the specification and twice in claim 1. Applicant believes the Examiner’s use of the word “moisturizing” was mistakenly taken from applicant’s description of this invention. One of several important differences between Taubl and the present invention is how the Taubl water pan is used. With Taubl the pan is essential. It must be used because it acts as a reservoir to contain a water bath. The pan creates a “bath” with a “bath surface.”

Applicant’s invention in contrast uses a thin film of water— see element “d” and “k” of new claim 26. Support is found in the specification at page 3, lines 25-27, and elsewhere as noted, where the water is sprayed on and the excess brushed off, “until the blank canvas is completely smooth and flat.” What applicant calls a “base pan” can be nearly flat. The base pan helps control the paper or canvas. See the definition of base pan in the Specification at page 12, lines 12-20.

Another difference is that Taubl does not use oil paint. Taubl uses “lacquer colorant to the surface of said bath.” See claim 1, element B, and throughout the specification. Taubl says,

“The colorant applied to the surface of the bath may be any lacquer. Lacquers are conventional compositions containing binder, pigment and a volatile liquid carrier. The binder is a high molecular weight acrylic

and/or vinyl polymer. Commonly, at least the majority of this binder is a poly(methylmethacrylate). The carrier may be either a solvent or dispersant which normally contains a predominant amount of ester, aromatic hydrocarbon and /or petroleum thinner. In either case, the lacquer dries by evaporation of the carrier.”

See Taubl at col. 2 lines 45-54.

This is important not because oil pigment looks different from lacquer, but because it acts different. Taubl uses a deep pan of water and applies the lacquer to the water, col. 2, lines 64-65. The lacquer is allowed to dry on the water. The lacquer dries because the lacquer paint has aromatic hydrocarbons and is volatile. After the paint dries on the water the artist then lifts up the transferring medium to collect the color. “At least sufficient colorant to form a continuous film over the bath surface is preferred.” Putting the film of color on the surface of the water is critical. Any marbling or patterning is done to the color on the water. “...patterning can be affected by spraying a solvent onto the film surface.” See Taubl at col. 3, line 12. This colored film is then allowed to dry on the surface of the water. The drying takes place because the color is acrylic type with a volatile liquid carrier. “After the colorant has been applied to the bath surface (and optionally patterned) it is dried until a flexible film is produced. This film will adhere to the substrate on contact. For some colorants, this condition is achieved almost immediately.” Col. 3, lines 21-27.

Nothing like this is used or described by the pending invention. Applicant uses oil, not volatile solvents and acrylic paint. If oil were used on water in the manner of Taubl it would take a very long time indeed to dry. The Taubl paintings don’t put the paint on paper or canvas but rather a transfer medium, which is “a flexible carrier sheet of, for example, a plastic such as polyethylene or cellophane is employed as a temporary substrate ...” col. 3 lines 60-62. And preferably the plastic is a sponge. Col. 4, line 27. Applicant’s paintings are created on paper or canvas. Applicant uses a masking technique, something Taubl never mentions. When Applicant’s mask technique is used to transfer color, the transfer painting must be wet with the oil color for the transfer to take place, it cannot be allowed to dry or there will be no transfer of paint. This is exactly opposite of Taubl. Taubl waits for the color to dry on the water, then picks it up

with the transfer paper. “This important and must be done ...” Taubl, Col. 3, lines 21-27.

Another important difference between Taubl and Applicant’s invention is how the water is applied and used. Applicant’s invention only works with a thin film of water. Applicant’s process does not work if the water layer is thick and there is no interaction between the oil pigment and the surface of the paper or canvas. If the water depth is great enough to remove any interaction between water and paper or canvas then it will not be possible to accurately direct the flow of color on the paper or canvas. All of the art cited by the Examiner, taken either alone or in combination, does not teach or even begin to suggest applicant’s invention. Applicant’s invention is not oil spreading on water. It is a purposeful directed technique of moving oil on a thin film of water, such that one can deliberately create specific shapes and patterns. This is then done twice, the second time with the mask technique.

Finally, when Taubl does create patterns it is done with a mechanical tool to form the desired pattern, not by moving the base pan with paper or canvas. A wooden rod or comb is used to mechanically overlay the colorant (col. 3, line 1-5 of the ‘989 patent.) Taubl must use mechanical means because moving the pan of water would not achieve much, except spilling the water, as opposed to applicant’s technique where moving the paper or canvas is important to making specific images.

Stimson (US 4,490,413), Mitchell (US 4,378,387), Latham (US 5,348,766) and the two children’s water art fun activities, cited by the Examiner, are discussed below.

Stimson, ‘413. This method floats paint on water. “A method for producing a painting using a flotation process in which a floating elongate member is placed in a shallow pan of water and one or more oil based litho inks having different viscosities are placed on the surface of the water...” See abstract top. Lower down in the abstract, “The paint pattern is lifted off the surface of the water...” This oil floated on water is like Taubl, distinguished above. All of the arguments and comments above about Taubl, apply equally to Stimson.

Mitchell, ‘387. This method floats paint on water. “The marbled patterns are produced by floating and combining marbling ink on the surface of a bath of size solution.” Abstract, second sentence. Also claim 1. Mitchel uses oil floated on an

aqueous solution, like Taubl, distinguished above. All of the arguments and comments above about Taubl apply equally to Mitchell.

Latham, '766. The title reads, Method For Marbleizing An Object By Dipping The Object Into Paint Floating On Borax-Conditioned Water.” The description is true to the title and refers to “... floating multiple color paints on the surface of the conditioned water. See abstract, first sentence. Following from claim 1, line two, at col. 7, line 39, “...floating a first oil-based paint containing at least one diluent on a surface of water which has been conditioned...”(Emphasis added.) This oil floated on an aqueous solution is like Taubl, distinguished above. All of the arguments and comments above about Taubl apply equally to Latham.

The children’s art reference, “Water Art - Shoalhaven Water” similarly refers to putting oil onto a pool of water. From the reference, “Next, dribble some dilute oil-based paint on to the water.” Then paper is laid onto the oil pattern. See description. Once again water is placed in a pan and oil is used to create a pattern on the water. The oil is then lifted off the water. There is no hint or description of how the oil is to be diluted or mixed with the oil. This is contrary to and not suggestive of Applicant’s invention, which uses oil on a wet surface. All of the arguments and comments above about Taubl apply equally to this children’s art reference.

Talmas, the other children’s water art reference, “Think Again, Preschool Education” refers to mixing one color in water, then mixing another color in oil, then using a dropper to drop “two or three drops of water” and “two or three drops of oil” onto the paper. Here the water is colored, and only few drops are used, not sufficient to wet the paper to allow a flowing effect. It would not be possible to make a planned pattern. In addition to describing only a few drops of water, itself insufficient to create the flowing effects of the invention, this reference only describes the application of 1-3 three drops of oil. Even if the paper were properly wetted this small amount of oil would be insufficient to produce a flowing effect.

Talmas does not teach how the oil is to be mixed or in what ratios.

Talmas does not teach using two or more oils.

By its plain language the Talmas process teaches away because it says, “... oil and water don’t mix.”

Talmas describes itself as a “Science and Art” project that shows children what lovely patterns can be created because “of course, we all know that water and oil do not mix.” This teaches away from Applicant’s invention and would not lead one to use the process in order to make oil flow in a directed manner with water.

Unlike Talmas, applicant’s process never uses colored water or “water colors” in the traditional sense of water soluble color. The reference requires it. Applicant creates directed designs using a wetted paper, using spray on brush off water and further using a special and defined pigment oil mixture. Talmas never describes a 1:1 pigment paint mixture. Applicant never mixes pigment with water. This children’s project does not and cannot be used to teach anyone how to make specific designs or to produce anything like applicant’s paintings.

The Examiner cites Lynden as “teaching multi-step painting including painting a canvas (fig. 1) and letting the paint dry. Thereafter a mask is used.” Applicant responds that Lynden (US 2,651,871) is indeed a mask technique. Lynden dates from 1953 and teaches a traditional method of “applying a stencil to such surface, applying paint of one color to such surface through said stencil, etc.” The steps are then repeated. Applicant’s masking technique is very different from using a stencil and then applying paint through the shape of the stencil. Applicant first uses the oil water technique to create an image which is then delineated by the mask before transfer to a previously prepared oil water painting prepared using the same novel technique. The transfer of the masked out painting must happen after the mask painting is made but while it is still wet and capable of transferring the oil. Lynden simply sprays paint through a mask.

The Examiner asserts it would have been obvious to one of ordinary skill in the art to have provided the invention of Taubl with a painting canvas and letting the paint dry, thereafter using a mask and painting the already painted canvas with another design in light of the teaching of Lynden, in order to provide a multi-patterned canvas. Furthermore, the Examiner asserts it would have been obvious to provide the invention of Taubl/Lynden with placing a blank canvas inside a base pan, moisturizing the blank canvas to form a film of water, depositing one or multiple flowing colors on the wetted blank canvas, directing the flowing colors...” Applicant believes clarification to the Examiner’s remarks is needed. The Examiner has erroneously incorporating Applicant’s

invention into the prior art by suggesting Taubl teaches a directed method of painting a canvas. Taubl paints the water, not the canvas. Taubl does NOT teach using a “moisturized” wetted paper or canvas. Taubl prefers to collect the paint on a piece of plastic so it won’t fall apart under water as paper might. Applicant does not “mask” the base painting. Applicant “masks” the transfer paper, unlike Lynden.

The Examiner combines several art documents, Taubl plus Talmas, Taubl plus Water Art, Taubl plus Lynden, but any and all combinations fall far short of applicant’s process. Each different reference has none of the elements in Applicant’s 19 step procedure, combining them doesn’t help. The cited references are all quite different when compared to Applicant’s invention.

None of the references teach or suggest the referenced art procedures can be combined with other styles or methods. Even when all 6 references cited by the Examiner are combined, there is simply no suggestion to use a thoroughly wetted canvas and then painted pigment mixed with oil, which is then combined with a novel masking technique. The world simply did not know it was possible to make a painting like this, until the inventor, Bihua Liu, taught it with his patent publication.

Applicant would also like to address the Examiner’s last comment that the amounts of oil used and made a part of the claim language are essentially not relevant because one of ordinary skill could figure them out. Once again this is hindsight reasoning. New claim 26 above identifies the optimal ratio of pigment to oil, 1:1. If the oil is not mixed in proper proportions with the pigment, the process won’t work. At least equal parts paint and oil should be used. It is a critical element that adds novelty to the claim. The oil must be made to “flow” on damp paper or canvas. If the oil does not flow on wetted paper or canvas then one is not using the claimed process. Oil pigment out of a paint tube will not work. Add too much or too little oil to the pigment and it will not work as claimed here. Pigment must be properly mixed, in a 1:1 ratio, to achieve the desired effect. The Examiner says this would be learned as “routine skill.” Applicant asks how can something never done before, be done routinely? Now that the technique is published, there will there be routine experimentation. It is surprising the technique works and can achieve the desired effects.



Applicant has explained why the subject invention pending here is not an invention based on a combination of elements found in the prior art. As such the recent Supreme Court case *Teleflex v. KSR*, 127 S. Ct. 1727; 82 USPQ2D 1385, is not on point and does not apply to these facts. There is no simple substitution, addition of an element, or variation in prior descriptions that one could look to and produce Applicant's 19 element step by step invention. There was no known problem looking for an obvious solution. Teleflex does however provide valuable advice when it suggests against "a temptation to read into the prior art the teaching of the invention in issue." *Teleflex* at 127 S. Ct. at 1742 citing *Graham v. John Deere*, 383 U.S. 1 at 36, 86 S.Ct. at 684.

As a supplement to this response applicant has attached color paper copies of three paintings created by Applicant's process. Applicant provides these to show the directed deliberate images than can be produced using the claimed process, unlike the images possible made using painting techniques disclosed in the prior art. Applicant notes however, that only the novel process is claimed here, not the finished paintings. It might be possible to achieve similar results to applicant's process using other methods. Applicant's process sometimes does result in a "marbled" look. But applicant is not claiming a marbled look. The process claims here should be considered not as product claims or even product by process claims. While it is possible to produce a novel painting using the claimed process, the end result is not relevant except to show that some of the references cited simply could not produce an image like the applicant's process.

The remaining new claims, 27-37 are all dependent on claim 26 and have all of its limitations. Support for the new claims can be found throughout the specification, and as described above, most were previously submitted. The new claims introduce no new matter.

Applicant believes that the amendments have overcome all the rejections and objections. The claims are in condition for allowance. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. If the Examiner believes that personal communications will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this application is respectfully requested.

Respectfully submitted,



Thomas A. Wootton, Attorney  
Registration No. 35,004

Date: 16 Oct 2007

Miller Canfield Paddock and Stone

Telephone No. (269) 383-5885 (direct)

Telefax No. (269) 383-5828

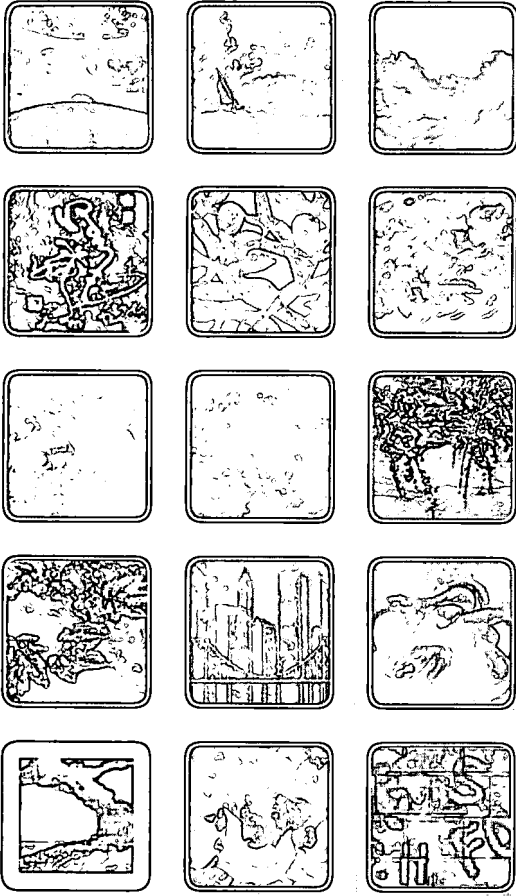
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# Flowing Colors Painting



LOVE 24X30

# Flowing Colors Painting



MEADERING STREAM 30

# Flowing Colors Painting



FLOWING MAPLE LEAVES